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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BRINICH, STEPHEN M

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

04/15/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27074@oliff.com
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Office Action Summary	Application No. 10/830,111	Applicant(s) RAHMAN ET AL.	
	Examiner STEPHEN M. BRINICH	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,15,19,20 and 22-26 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,15,19,20 and 22-24 is/are rejected.
- 7) ☒ Claim(s) 3-6,8,25 and 26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see Appeal Brief filed 1/2/09, with respect to the rejection(s) of claim(s) 1-6, 8, 15, 19-20, & 22-26 under 35 USC §103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are set forth in view of Sano et al, Eldridge et al, Henry et al, and "Xerography and Photocopying".

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 & 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Sano et al (US 6348940).

Re claims 1 & 20, Sano et al discloses (column 13, lines 21-39; Figure 14) an image forming device and operation method thereof in which an image scanner scans an input document to obtain input image data and a computer that processes digital graphic element data (inherently supplied by a user via placing

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image files in the computer's storage). The image data from the image scanner and the graphic element data formed by the computer are combined into a composite image and output in the form of an index image (column 13, lines 31-37).

4. Claims 1 & 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Eldridge et al (US 6064492).

Re claims 1 & 20, Eldridge et al discloses (column 1, lines 20-34) an image forming device and operation method thereof in which input image data is obtained from a source (with a scanner being specified as one option for the source of this input image data) and a digital graphic element is formed from user-supplied digital graphic element data (specifically, text characters). The input image data and the digital graphic element data (text) are combined into a composite image (page description language representation) and output via a printer server connected to a printer.

5. Claims 1-2, 15, 20, & 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Henry et al (US 6898625).

Re claims 1 & 20, Henry et al discloses (column 4, line 59 - column 7, line 18, particularly the excerpts thereof noted below; Figure 2) an image forming device and method in which an image source scans an input document to obtain image data (column 4, line 65 - column 5, line 5) and accepts user-supplied

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digital graphic element data (e.g. a message 210; column 5, lines 44-57; one version of message 210 is described as a string of ASCII characters, which are a form of digital data; column 6, lines 57-59). The scanned input document and user-supplied digital graphic element data are combined into a composite image electronic document (column 5, lines 6-19; Figure 2), which is printed by an output device (column 6, lines 1-9).

Re claims 2 & 22, Henry et al discloses (column 5, lines 50-57) that the user-supplied digital graphic data may be either user-customized or a selection from a standard menu (which must inherently be stored in order for the menu items to be available for selection after the menu has been initially created). This user-supplied digital graphic data is then stored as part of the electronic document.

Re claim 15, Henry et al discloses (column 6, line 6) the use of a photocopier as the image forming device.

Re claim 23, Henry et al further discloses (column 5, lines 53-57) the use of an input interface to select one of multiple predefined (and thus inherently previously entered by a user) digital graphic data elements from a menu.

Re claim 24, Henry et al further discloses (column 5, lines 50-51) the selection of an attribute (text characters or graphics) of the user-supplied digital graphic data.

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Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henry et al in view of "Xerography and Photocopying" by George Watson, University of Delaware (referenced as "Xerography and Photocopying").

Re claim 19, as noted above Henry et al describes the use of a photocopier to form an image, but does not specify that the photocopier is xerographic.

It is well known to one of ordinary skill in the art that a standard photocopier uses a xerographic process to place images on paper, as taught for example by "Xerography and Photocopying".

Henry et al and "Xerography and Photocopying" are combinable because they are from the field of document photocopying.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use xerographic technology to implement the (not further specified) "photocopier" of Henry et al.

The suggestion/motivation for doing so would have been to implement a "photocopier" function using standard off-the-shelf photocopier technology.

Therefore, it would have been obvious to combine Henry with "Xerography and Photocopying" to obtain the invention as specified in claim 19.

Allowable Subject Matter

8. Claims 3-6, 8, & 25-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Re claims 3 & 26 (and dependent claims 4-6 & 8), the art of record does not teach or suggest the recited selection of digital graphic element data positioning in conjunction with the recited arrangement of compositing the digital graphic element and a scanned input document in order to form a composite image.

Re claim 25, the art of record does not teach or suggest the recited selection of the recited digital graphic element data elements in conjunction with the recited arrangement of

compositing the digital graphic element and a scanned input document in order to form a composite image.

Conclusion

9. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor Edward Coles can be contacted at 571-272-7402.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300.

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Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

/S. M. B./

Examiner, Art Unit 2625

/Edward L. Coles/

Supervisory Patent Examiner, Art Unit 2625